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ETH 1623

REMARKS

In response to the Office Action dated June 23, 2003, the time for response having been extended by petition, Applicant submits the following remarks. Claims 47-60 and 63 remain in this application.

The Examiner rejected claims 47-60 and 63 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner restates the definitions of "deformable" and "curable" and indicates confusion as to whether Applicant is claiming a tubular member formed of a deformable or curable material. Applicant respectfully traverses this rejection.

As explained in the specification at least at pages 3 and 4, Applicant describes two classes of inventions. The first are devices formed of "deformable" materials and the second are devices formed of "curable" materials. As the Examiner points out, each type of material is well-defined. Applicant has clearly claimed in claim 60 that the fastener comprises "a tubular member formed of a deformable material". Further, while the specification contains support for the transformable limitation ("the tubular member being transformable upon application of energy to the tubular member between a fluent state in which the tubular member is radially expandable to permit radial expansion of the graft lumen vessel, and a non-fluent state in which the tubular member retains the end portion of the graft lumen in its expanded state in sealing engagement with the target vessel") of the claim. As the Examiner points out, page 3, line 30 to page 4, line 1 of the specification states that deformable material "may be transformed from a solid, non-fluent state to a moldable, fluent state in vivo upon the application of energy, such as light energy or heat, to the material." This statement provides support for the transformable limitation.

The remainder of the Examiner's rejections are described in the event that Applicant intended to claim a curable material. As described above, Applicant claims "a tubular member formed of a deformable material" in the only pending independent claim, claim 60. As a result, Applicant submits that the claims are definite, and requests that the Examiner withdraw the rejection.

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The Examiner rejected claims 49-55 and 58-60 under 35 USC §102(e) as being anticipated by Slepian (US Patent No. 5,634,946). The Examiner states that the claims were interpreted "to cover a curable material, rather than a deformable tube", and uses Slepian to reject the claims on the basis that Slepian discloses curable materials. Applicant traverses this rejection.

As described above, Applicant is not claiming curable materials. Applicant clearly claims "a tubular member formed of a deformable material". Slepian does not describe or suggest, as claimed in claim 60, a fastener comprising a tubular member formed of a deformable material. The Examiner acknowledges this fact by the very structure of the rejection. Rather than rejecting claim 60 as being disclosed or taught by Slepian, the Examiner interprets claim 60 to cover a curable material, rather than a deformable tube. By implication, Slepian does not describe the elements of claim 60. As a result, Applicant submits that the 102 rejection should be withdrawn as to the independent claim 60, and the claims that depend therefrom.

The Examiner further rejects claims 56-57 under 35 U.S.C. 103(a) as being unpatentable over Slepian in view of Pathak (5,662,712); and claim 63 under 35 U.S.C. 103(a) as being unpatentable over Slepian in view of Hubbell (5,410,016). Each of these rejections relies upon Slepian as the primary reference. As a result, the combination of Pathak or Hubbell with Slepian fails to teach or suggest the elements of the independent claim, or the dependent claims 47-59 and 63, respectively.

The Examiner rejected claim 60 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6,110,188 in view of Slepian. The Examiner states that "U.S. Patent No. 6,110,188 fails to claim the material is transformable upon the application of energy between a fluent state and a non-fluent state", and then relies on Slepian's curable coating disclosure to render claim 60 as obvious. While Applicant submits that Slepian's curable coating disclosure does not render claim 60 obvious in view of claim 46 of the '188 patent, Applicant has submitted a terminal

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disclaimer to overcome the rejection, and as such requests the Examiner to withdraw the rejection.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case, and request the Examiner to contact the undersigned representative in the event that a conference would clarify any remaining issues.

Respectfully submitted,

By: BST
Brian S. Tomko
Reg. No. 41,349

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-1239
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